

Remarks

Applicants have carefully reviewed the Office Action mailed April 18, 2007, prior to preparing this response. Currently 1-27 are pending in the application, wherein claims 1-27 have been rejected. Claims 1, 5, 13, 23, 25 and 27 have been amended, claims 28 and 29 have been added, and claims 2, 4 and 22 have been cancelled with this paper. Support for the amendments may be found, for example, at lines 14-23 of page 4. No new matter has been added. Favorable reconsideration of the above amendments and following remarks is respectfully requested.

Claims 1-4, 6-8, 11-16, 18-19, 21-23 & 25-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Acciai et al., U.S. Patent No. 5,855,802, in view of Pacetti et al., U.S. Patent No. 6,695,920. Applicants respectfully traverse this rejection. Claims 2 and 4 have been incorporated into claim 1, and claim 22 has been incorporated into claim 13, making the rejection of these claims moot.

Claims 1 and 23 recite that the workpiece is positioned below the linear motor. Claim 13 includes the limitation that the tubular workpiece is positioned below the first motor. Claim 25 recites that the workpiece is positioned below the one or more motors. Claim 27 includes the limitation that the tubular workpiece is positioned below the bottom surface of the common base.

In order to establish a *prima facie* case of obviousness, each and every limitation must be taught or suggested by the prior art. See M.P.E.P. §2143.03. As indicated in the Office Action at page 3, “Acciai does not teach...the workpiece below the motor(s).”

The teachings of Pacetti additionally appear to fail to teach such a limitation of the claims. Namely, as shown in Pacetti, the workpiece (i.e., the stent 10) of Pacetti is shown positioned above the linear motor 28 of the mounting assembly.

The arrangement of a workpiece relative to motor(s) of the laser cutting system as currently claimed can prevent fluids used in the system or dross that is produced while laser cutting from getting on the one or more motors and/or the laser of the system. Other possible advantages of some arrangements of components are given in the specification, for example in paragraphs [0014] and [0015] of the published application.

As each and every limitation of claim 1 is not taught by the cited combination, a *prima facie* case of obviousness has not been established. Applicants assert claims 1, 13,

23, 25 and 27, as well as claims 3, 6-8, 11-12, 14-16, 18-19, 21 and 26 which depend from one of claims 1, 13, 23, 25 and 27, are in condition for allowance. Withdrawal of the rejection is respectfully requested.

Claims 5, 9, 17, 20 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Acciai et al., U.S. Patent No. 5,855,802, in view of Pacetti et al., U.S. Patent No. 6,695,920, and further in view of Tessier et al., U.S. Patent No. 5,073,694. Applicants respectfully traverse this rejection.

As discussed above, neither Acciai nor Pacetti seem to teach a workpiece positioned below motor(s) of a device for manufacturing a stent. Tessier fails to remedy the shortcomings of Acciai and Pacetti. For at least this reason a *prima facie* case of obviousness has not been established. Withdrawal of the rejection of claims 5, 9, 17, 20 and 24 is respectfully requested.

Furthermore, the Examiner cited several cases in an attempt to support the *prima facie* case of obviousness. See page 4 of the Office Action. Applicants respectfully assert that these cases are not on point with the current application, and therefore cannot be used to render the claims obvious.

The Examiner cited *In re Wolfe*, 251 F.2d 854, (CCPA 1958) in which making elements integral was held to have been obvious. Applicants do not see, and it has not been explained in the Office Action, how *In re Wolfe* is applicable to the current claims. Namely, upon reviewing the claims, there appears to be no recitation in which elements are claimed to be integral. As such, it does not appear that this case law applies to the pending claims.

The Examiner also cited *In re Gazda*, 219 F.2d 449, (CCPA 1955) in which the reversal of parts was held to be obvious. Applicants assert that, for at least two reasons, this precedent does not lead to the conclusion that the claims are obvious. First, the current claims do not appear to be a reversal of parts of any of the cited references or of any combination of these references. Applicants do not see, and it has not been explained in the Office Action, how the parts of Acciai, Pacetti, or Tessier, or any combination thereof, are a reverse configuration of any of the claimed arrangements. As such, it does not appear that this case law applies to this situation.

Further, even if this case law did apply, this case still requires “a sufficient suggestion” to make the proposed modification. See *Gazda*, 219 F.2d at 452. In other words, there still must be some suggestion or motivation present in the prior art to make the proposed modification of the prior art. Applicants assert that no such suggestion or motivation exists in the cited prior art to make the proposed modification, and as such the claims are allowable over these references.

The Office Action also cited *In re Japikse*, 37 CCPA 1026, (CCPA 1950), in which the rearrangement of parts was held to be obvious. Specifically, changing the location of a switch in the device in Japikse was held to be obvious because “it was held that there would be no invention in shifting the starting switch ... to a different position since the operation of the device would not thereby be modified.” *Japikse*, 37 CCPA at 1031. In other words, the claim in Japikse was apparently held to be obvious because the rearrangement did not change the operation of the device. Applicants assert that this precedent is inapplicable to the current application. Namely, the arrangements recited in the claims can have a number of advantages over prior art configurations. In some cases, the arrangements can prevent fluids used in the system or dross that is produced while laser cutting from getting on the one or more motors and the laser. Other possible advantages are given in the specification, for example in paragraphs [0014] and [0015] of the published application. Thus, because the arrangements of the current claims can change the operation of prior art cutting systems, *In re Japikse* is not controlling precedent in this case.

Further, it was stated in the Office Action that “substitution of a known equivalent” has been held obvious, citing *In re Kuhle* and *In re Ruff*. Especially in light of the possible advantages discussed in the previous paragraph, Applicants do not see how the arrangements of the current claims can be called equivalents of the devices disclosed in the cited prior art. As such, Applicants assert that this case law cannot be used to establish the obviousness of the current claims.

Because none of the cited references, alone or together, disclose the arrangements of the current claims, and because the case law cited by the Examiner does not apply to the current case, Applicants assert that the claims are allowable over the cited references.

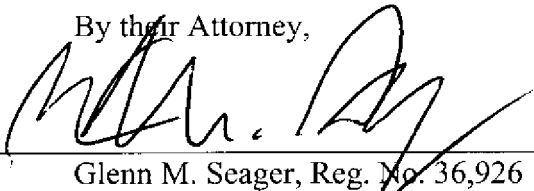
Reexamination and reconsideration are requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is also respectfully requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

KENNETH MERDAN ET AL.

By their Attorney,

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